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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,871	10/06/2003	Barbara Chabut	P26,257-B USA	3835
23307	7590	07/10/2006	EXAMINER SELLERS, ROBERT E	
SYNNESTVEDT & LECHNER, LLP 2600 ARAMARK TOWER 1101 MARKET STREET PHILADELPHIA, PA 191072950			ART UNIT 1712	

DATE MAILED: 07/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/679,871	Applicant(s) CHABUT ET AL.	
	Examiner Robert Sellers	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37, 39, 40, 42, 44 and 45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37, 39, 40, 42, 44 and 45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) ☐ Notice of References Cited (PTO-892) | 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) ☐ Notice of Informal Patent Application (PTO-152) |
| 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) ☐ Other: _____ |

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1. The 35 U.S.C. 112, second paragraph rejection with respect to the lack of definition of active components in the acronym "pbwa" in claims 4, 5, 19, 20, 34 and 35 is rescinded since page 6, lines 2-4 of the specification denotes "active components" as "those components which participate in curing of the composition, either directly as a reactant or indirectly as a catalyst, inhibitor or the like," thereby including the claimed curing catalyst and activator.

2. The insertion of the denominator of "1" into the weight ratios of vinyl ester to ethylenically unsaturated monomer into claims 7, 10, 22, 25, 37 and 40 provides a concise indication of the actual parameter of the ratio. The denominator should also be included in the weight ratios described on page 15, lines 1-3 of the specification for the sake of consistency.

The text of those sections of Title 35, U.S. Code and the obviousness-type double patenting not included in this action can be found in a prior Office action.

Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. There remains no revelation as to the limits for the moiety quantified by "n" in the epoxy compound of formula (I) in claim 1. The range of "n" being from 1 to 5 should be inserted after line 15 as supported by claim 1 originally filed October 6, 2003 as well as on page 12, line 17 of the specification filed March 3, 2004.

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4. Claims 1-37, 39, 40, 42, 44 and 45 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-51 of copending Application No. 10/679,806. Although the conflicting claims are not identical, they are not patentably distinct from each other for the reasons espoused in the non-Final rejection mailed February 16, 2006 wherein the copending application claims the same components as those instantly claimed with the additional presence of a reactive multifunctional acrylate.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1, 2, 4, 5, 7, 10, 16, 17, 19, 20, 22 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Yonetani et al. Patent No. 6,015,845.

Claims 16-20, 22 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by European Patent No. 199,671 (Gebauer) or Japanese Patent No. 2001-89716 (Seiji).

Claims 16 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Goto et al. Patent No. 4,729,666.

Claims 31-35, 37 and 40 have been removed since independent claim 31 has been limited to vinyl toluene for ethylenically unsaturated monomer b. Otherwise, the rejections are maintained for the reasons of record set forth in the non-Final rejection. The arguments filed June 19, 2006 have been considered but are unpersuasive.

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5. The moiety $R_x\text{-Ar-R}_x$ in the epoxy compound of formula (I) in claim 1 or the polymerizable vinyl ester of formula (II) in claim 16 emanates from a bisphenol A diglycidyl ether as set forth on page 10, lines 20-24 of the specification and indicated as the elected species in the non-Final rejection on page 2, paragraph 1, lines 2-3 wherein "x" and "z" are zero and Ar is the diether of isopropylidene diphenol. Yonetani et al., Gebauer, Seiji or Goto et al. report vinyl esters derived from the elected species of a bisphenol A epoxy resin.

6. Independent claim 1 is open to any styrene-free vinyl ester-reactive ethylenically unsaturated monomer including multifunctional species such as the reactive double bond-containing carboxylic acid esters of Yonetani et al. (col. 2, line 51 to col. 3, line 17). Independent claim 16 embraces any vinyl-ester reactive ethylenically unsaturated monomer including the exemplified styrene and divinylbenzene of Gebauer (CAPLUS abstract), or the styrene shown in Seiji (CAPLUS abstract) or Goto et al. (col. 11, Example 1).

Claims 13-15 and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yonetani et al., Gebauer and Seiji.

The rejection is maintained for the reasons of record set forth in the non-Final rejection. The arguments filed June 19, 2006 have been considered but are unpersuasive.

7. Yonetani et al., Gebauer and Seiji set forth a bisphenol A epoxy acrylate resin wherein the bisphenol A epoxy resin is within formula (I) of claim 1 and the bisphenol A epoxy acrylate is encompassed by formula (II) of claim 16, the elected species of benzoyl peroxide, and a vinyl ester-reactive ethylenically unsaturated monomer useful in the same utility as that claimed as an adhesive for anchoring a bolt or plug. The formulations of the prior art inherently possess the claimed pull out performance based on the equivalent components and utility of the prior art and claims. The motivation for the inherency rests on the equivalent components and utility between the patents and claims. The burden of proof resides with applicants to provide evidence establishing the criticality of the claimed property over the closest prior art exemplified compositions of the references.

Claims 1, 4, 6-16, 19 and 21-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goto et al. and Parish et al. Patent No. 5,891,942.

The rejection is maintained for the reasons of record set forth in the non-Final rejection. The arguments filed June 19, 2006 have been considered but are unpersuasive.

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8. Parish et al. by addresses the limitations particularly of independent claims 1, 16 and 31 due to the recitation of a vinyl ester (col. 3, line 22), vinyl toluene (col. 3, lines 22-24 and 36-43), a benzoyl peroxide catalyst (col. 5, line 3) and an accelerator such as N,N'-dimethyl-p-toluidine (col. 5, line 52).

Although the accelerator is not required, it would have been obvious to employ the accelerator disclosed in Parish et al. in order to decrease the curing time (col. 5, lines 39-40 and 52).

9. Parish et al. clearly espouses a vinyl ester as the resin component in column 3, lines 16-17 and 21. Although the structure of the vinyl ester is not revealed, it would have been obvious to employ the bisphenol A epoxy acrylate resin of Goto et al. (col. 5, lines 9-13) as the vinyl ester of Parish et al. in order to optimize the adhesion of the coating to a substrate (Goto et al., col. 3, lines 10-19).

10. The teachings of Parish et al. and Goto et al. are not incompatible since both are directed to blends of vinyl esters, vinyl toluene, benzoyl peroxide catalyst and dimethyl-p-toluidine catalyst. The use of the same components within the blends of patentees establishes the combinability of the references even if the ultimate intended utilities are different. The motivation to optimize the adhesion garnered from Goto et al. is entirely consistent with the objectives of the coating composition of Parish et al.

11. Parish et al. discloses as little as about 30 weight percent of resin component such as a vinyl ester falling within the claimed maximum of about 30 wt% in claim 31.

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Claims 6, 8, 9, 11, 12, 21, 23, 24, 26, 27, 31-37, 39, 40, 42, 44 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gebauer and Seiji in view of Goto et al. and Parish et al.

Claims 31-35, 37, 40, 44 and 45 have been included since they are dependent upon independent claim 31 now confined to vinyl toluene. Otherwise, the rejection is maintained for the reasons of record set forth in the non-Final rejection. The arguments filed June 19, 2006 have been considered but are unpersuasive.

12. The motivation to use the vinyl toluene of Goto et al. and Parish et al. as the reactive diluent of Gebauer and Seiji is to reduce the volatility and prevent the emission of environmentally hazardous styrene vapor (Parish et al., col. 3, lines 36-43). Such a feature is desirable and beneficial regardless of the system wherein vinyl toluene is incorporated. Furthermore, the formulations of Parish et al. as compared to Gebauer, Seiji and Goto et al. are similar with respect to the equivalent vinyl ester, benzoyl peroxide catalyst and toluidine-based accelerator.

13. Yonetani et al. is not involved in the instant rejection.

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Claims 31-37, 39, 40, 42, 44 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goto et al. in view of Gebauer.

14. Goto et al. in Example 1 (col. 11) shows a level of bisphenol A epoxy diacrylate of 56.1% by weight which is outside of the newly claimed range of from about 10 wt% to about 30 wt% in independent claim 31. However, the teachings of a reference are not confined to the examples since Goto et al. is not particular as to any proportion of bisphenol A epoxy diacrylate. It would have been obvious to employ the bisphenol A epoxy diacrylate of Goto et al. within the concentrations of from 9-28% by weight in Gebauer (page 1) in order to optimize the strength, toughness and resistance to ageing and weathering (Gebauer, Derwent abstract, Basic Abstract and Use/Advantage sections).

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The amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Sellers whose telephone number is (571) 272-1093. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).



Robert Sellers
Primary Examiner
Art Unit 1712